

Bldg/Room

United States Patent and Trademark Office

P.O. Box 1450

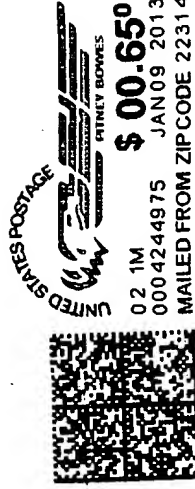
Alexandria, VA, 22313-1450

If Undeliverable Return in Ten Day

OFFICIAL BUSINESS

PENALTY FOR PRIVATE USE, \$300

AN EQUAL OPPORTUNITY EMPLOYER



RECEIVED

FEB 04 2013

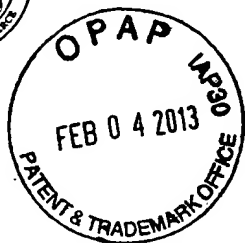
USPTO MAIL CENTER

6060432121 1005

[illegible]

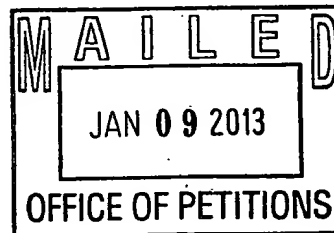


UNITED STATES PATENT AND TRADEMARK OFFICE



IFW-
Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

STEVEN & TRYBUS
ROPER & QUIGG
200 SOUTH MICHIGAN AVENUE
SUITE 1000
CHICAGO IL 60604



In re Patent No. 6,722,108 :
Issued: April 20, 2004 : ON PETITION
Application No. 09/338,158 :
Filed: June 22, 1999 :
For: COUPON INSERTING APPARATUS :

This is in response to the petition under 37 CFR 1.378(c), filed October 1, 2012, to accept the unintentionally delayed payment of the second maintenance fee for the above-identified patent.

The patent issued on April 20, 2004. The grace period for paying the second maintenance fee expired on April 21, 2012.

On May 29, 2012, a petition under 37 CFR 1.378(c) was filed and signed by purported assignee, C. Joyce Witt. The petition included a certification signed by C. Joyce Witt indicating that she was empowered to act on behalf of the assignee of the entire interest, as well as identified the reel and frame number where the purported assignment to C. Joyce Witt was recorded. The Office could not process the credit card authorization form for payment of the required maintenance fee and surcharge because the credit card was declined.

On September 6, 2012, a second petition under 37 CFR 1.378(c) was filed and signed by Anthony J. Nowakowski. The petition was accompanied by payment of the second maintenance fee and the surcharge for late payment due to unintentional delay.

On September 17, 2012, the Office mailed a decision in response to the petition filed May 29, 2012, and the supplemental petition filed September 6, 2012. The decision stated there was no indication in the USPTO's records that Mr. Nowakowski is an attorney or agent registered to practice before the USPTO. Furthermore, Mr. Nowakowski did not establish that he had authority to sign on behalf of an assignee. The decision further stated that the Office would not presume from the filing of the petition and payment of the requisite fees that Mr. Nowakowski was a proper party pursuant to 37 CFR 1.378(d). Accordingly, the Office concluded that the petition submitted by Mr. Nowakowski was improperly signed and would not be treated on the merits.

On October 1, 2012, a petition under 37 CFR 1.378(c) was filed and signed by Anthony J. Nowakowski. The petition was accompanied by a Statement under 37 CFR 3.73(b) signed by Anthony J. Nowakowski, V.P. Engineering, stating that C. Joyce Witt, an individual, is the assignee of the entire right, title, and interest in the patent by virtue of an assignment from the inventor, and that the assignment was recorded in the USPTO at Reel/Frame 024066/0886 and Reel/Frame 025497/0186. Additionally, C. Joyce Witt submitted a change of correspondence address, as well as a communication empowering Anthony J. Nowakowski to sign on her behalf with regards to patent matters.

Pursuant to 37 CFR 1.378(d), "Any petition under [37 CFR 1.378] must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest." A person or organization whose only responsibility as to the patent is the payment of the maintenance fee is not a party in interest for purposes of 37 CFR 1.378. See MPEP 2590. If a person not registered to practice before the Office signs the petition, the petition must indicate that the person signing the petition is the patentee, assignee, or other party in interest. Id. An assignee must comply with the requirements of 37 CFR 3.73(c). Id.

Initially, the Office notes that no assignment from inventor Thomas George Kotsiopoulos to C. Joyce Witt was ever recorded with the USPTO. Thus, the chain of title from the inventor to Ms. Witt is unclear. Mr. Nowakowski indicated that Ms. Witt is the assignee of the entire right, title, and interest in the

patent by virtue of an assignment from the inventor, and that the assignment was recorded in the USPTO at Reel/Frame 024066/0886 and Reel/Frame 025497/0186. However, the documents recorded at Reel/Frame 024066/0886 and Reel/Frame 025497/0186 are not assignments of ownership interest in the patent from the inventor to Ms. Witt, but rather are a lien and an assignment of security interest. Without a copy and recordation of the assignment of ownership interest from the inventor to Ms. Witt, it is not apparent that she is the assignee of the entire right, title, and interest in this patent. **Before Ms. Witt may file any further petition or other documents in this matter, she must establish that she is the assignee by submitting a copy of the assignment of ownership from the inventor to her for recordation in the USPTO and complete the accompanying Statement under 37 CFR 3.73(c).**

Assuming arguendo, Ms. Witt is the assignee, she may give power of attorney to one or more patent practitioners to act on her behalf in this patent matter. However, Ms. Witt is not permitted to empower another individual such as Mr. Nowakowski, who is not an attorney or agent registered to practice before the USPTO, to act on her behalf. The power of attorney from Ms. Witt to Mr. Nowakowski will not be entered.

In view of the above, the Office again concludes that the present petition submitted by Mr. Nowakowski is improperly signed, and therefore, will not be treated on the merits. Accordingly, the present petition is dismissed.

As Ms. Witt has not established that she is the assignee of the entire right, title, and interest in this patent, the Office will not enter the change of correspondence address. As a one-time courtesy, the Office will mail a copy of this decision to the address indicated on the petition. However, until otherwise instructed, the Office will mail all future correspondence regarding this patent solely to the address of record.

Petitioner should note that if this petition under 37 CFR 1.378(c) is not renewed, or if renewed and not granted, the maintenance fee and post-expiration surcharge are refundable. Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany the request.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By fax: (571) 273-8300
 ATTN: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Correspondence may also be submitted electronically via the USPTO electronic filing system.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Forms PTO/SB/66; PTO/AIA/96; PTO/AIA/123

Cc: Anthony J. Nowakowski
 2836 Corporate Parkway
 Algonquin, IL 60102

**PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF
MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378 (c))**

Docket Number (Optional)

Mail to: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Fax: (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

Patent No. _____

Application Number _____

Issue Date _____

Filing Date _____

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable

The above – identified patent

☐

Is a reissue of original Patent No. _____ original issue date _____

original application number _____

original filing date _____

☐

resulted from the entry into the U.S. under 35 U.S.C. 371 of international application _____

filed on _____

CERTIFICATE OF MAILING (37 CFR 1.89(a))

I hereby certify that this paper (*along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class main in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Date_____
Signature_____
Typed or Printed Name of Person Signing Certificate

[page 1 of 3]

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

1. SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
<input type="checkbox"/> \$ _____	3 ½ yr fee	(1551)	<input type="checkbox"/> \$ _____	3 ½ yr fee	(2551)
<input type="checkbox"/> \$ _____	7 ½ yr fee	(1552)	<input type="checkbox"/> \$ _____	7 ½ yr fee	(2552)
<input type="checkbox"/> \$ _____	11 ½ yr fee	(1553)	<input type="checkbox"/> \$ _____	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED \$ _____

4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) of \$ _____ (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of a maintenance fee.

SURCHARGE FEE BEING SUBMITTED \$ _____

5. MANNER OF PAYMENT

☐ Enclosed is a check for the sum of \$ _____

☐ Please charge Deposit Account No. _____ the sum of \$ _____

☐ Payment by credit card. Form PTO-2038 is attached.

6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

☐ The Director is hereby authorized to charge any maintenance fee, surcharge or petition deficiency to Deposit Account No. _____

7. OVERPAYMENT

As to any overpayment made please

OR

☐

Credit to Deposit Account No. _____

☐

Send refund check

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

8. STATEMENT

The delay in payment of the maintenance fee to this patent was unintentional.

9. PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED_____
Signature(s) of Petitioner(s)_____
Date_____
Typed or printed name(s)_____
Registration Number, if applicable_____
Telephone Number_____
Address_____
Address

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

ENCLOSURES☐

Maintenance Fee Payment

☐

Surcharge under 37 CFR 1.20(i)(2) (fee for filing the maintenance fee petition)

☐

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

CHANGE OF CORRESPONDENCE ADDRESS Patent

Address to:
Mail Stop Post Issue
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Patent Number

Issue Date

Application Number

Filing Date

First Named Inventor

Attorney Docket
Number

Please change the Correspondence Address for the above-identified patent to:

☐

The address associated with Customer Number:

OR

☐Firm or
Individual Name

Address

City

State

ZIP

Country

Telephone

Email

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

This form will not affect any "fee address" provided for the above-identified patent. To change a "fee address" use the "Fee Address Indication Form" (PTO/SB/47).

I am the:

☐

Patentee.

☐

If the Patentee was not the applicant for patent (37 CFR 1.42), then a Statement under 37 CFR 3.73(c) (Form PTO/AIA/96 or equivalent) is enclosed or was filed on _____. See 37 CFR 3.71.

☐

Attorney or agent of record. Registration Number _____

☐

Patent practitioner acting in a representative capacity whose correspondence address is the correspondence address of record. Notice has been given to the patentee or owner. Registration Number _____

Signature

Typed or
Printed Name

Date

Telephone

NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Post Issue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

STATEMENT UNDER 37 CFR 3.73(c)

Applicant/Patent Owner: _____

Application No./Patent No.: _____ Filed/Issue Date: _____

Titled: _____

_____, a _____

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that, for the patent application/patent identified above, it is (choose one of options 1, 2, 3 or 4 below):

1. ☐ The assignee of the entire right, title, and interest.
2. ☐ An assignee of less than the entire right, title, and interest (check applicable box):
- ☐ The extent (by percentage) of its ownership interest is _____%. Additional Statement(s) by the owners holding the balance of the interest must be submitted to account for 100% of the ownership interest.
- ☐ There are unspecified percentages of ownership. The other parties, including inventors, who together own the entire right, title and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

3. ☐ The assignee of an undivided interest in the entirety (a complete assignment from one of the joint inventors was made). The other parties, including inventors, who together own the entire right, title, and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

4. ☐ The recipient, via a court proceeding or the like (e.g., bankruptcy, probate), of an undivided interest in the entirety (a complete transfer of ownership interest was made). The certified document(s) showing the transfer is attached.

The interest identified in option 1, 2 or 3 above (not option 4) is evidenced by either (choose one of options A or B below):

- A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.
- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at

Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at

Reel _____, Frame _____, or for which a copy thereof is attached.

[Page 1 of 2]

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

STATEMENT UNDER 37 CFR 3.73(c)

3. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
 Reel _____, Frame _____, or for which a copy thereof is attached.

4. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
 Reel _____, Frame _____, or for which a copy thereof is attached.

5. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
 Reel _____, Frame _____, or for which a copy thereof is attached.

6. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
 Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet(s).

☐ As required by 37 CFR 3.73(c)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature _____

Date _____

Printed or Typed Name _____

Title or Registration Number _____

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.